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PENFIELD, NY 14526

EXAMINER
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CHANDLER, SARA M

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ELECTRONIC

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5 UNITED STATES PATENT AND TRADEMARK OFFICE  
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7  
8 BEFORE THE BOARD OF PATENT APPEALS  
9 AND INTERFERENCES  
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11  
12 *Ex parte* TERRENCE SICK, ERIC SCHNEIDER, and  
13 MICHAEL L. WEINER  
14

15  
16 Appeal 2009-000527  
17 Application 09/965,071  
18 Technology Center 3600  
19

20  
21 Decided:<sup>1</sup> June 10, 2009  
22

23  
24 *Before* MURRIEL E. CRAWFORD, ANTON W. FETTING and BIBHU R.  
25 MOHANTY, *Administrative Patent Judges*.

26  
27 CRAWFORD, *Administrative Patent Judge*.  
28

29 DECISION ON APPEAL  
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32  
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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 1-17. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants claim methods, systems and apparatuses for real-time, on-line computer searching and matching of database entries based on intellectual property and other user-selectable search criteria (Spec., p. 1, ll. 5-8).

Claim 1, reproduced below, is further illustrative of the claimed subject matter:

1. In an on-line financial screening service, a method of searching a financial database, including data for a plurality of companies, and an intellectual property database, including data for a plurality of companies, in order to find securities matching user search criteria and relevant intellectual property, wherein the users access the database over the Internet, the method comprising:  
searching the database for records matching financial search criteria defined by a user; and  
relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one; and  
reporting the matching records to the user, including at least one item of data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio, Earnings per Share Growth-1 Yr, Earnings per Share Growth-1 Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio.

1 The prior art relied upon by the Examiner in rejecting the claims on  
2 appeal is:

3 Rivette	US 5,991,751	Nov. 23, 1999
4 Black	US 6,012,042	Jan. 4, 2000

5 The Examiner rejected claims 3-6, 8, 9, 11-13 and 15-17 under  
6 35 U.S.C. § 102(e) as being anticipated by Rivette; claim 10 under 35 U.S.C.  
7 § 103(a) as being unpatentable over Rivette in view of Official Notice; and  
8 claims 1, 2, 7 and 14 under 35 U.S.C. § 103(a) as being unpatentable over  
9 Rivette in view of Black.

#### 11 ISSUES

12 Did the Appellants show the Examiner erred in finding that the patent  
13 bibliographic database 604, patent database 614 and financial database 638  
14 of Rivette include financial and intellectual property data for a plurality of  
15 companies as recited in independent claims 1, 3, 11, 16 and 17, because  
16 Rivette only discloses databases that store financial and intellectual property  
17 data for one company?

18 Did the Appellants show the Examiner erred in finding that Rivette  
19 discloses analyzing the number of common results on a company basis to  
20 determine if the number is greater than zero, and if not, relaxing the search  
21 criteria employed in at least one of the searching steps and rerunning the  
22 searches so as to obtain a non-zero number of common results as set forth in  
23 independent claim 1 and dependent claims 4, 5 and 13?

24 Did the Appellants show the Examiner erred in finding that Rivette  
25 discloses maintaining the financial database data records and the intellectual  
26 property database records, including periodically launching an automated

1 search of network resources to locate and update financial and intellectual  
2 property information as recited in dependent claim 6?

3 Did the Appellants show the Examiner erred in finding that Rivette  
4 discloses constructing a search query having both financial search criteria  
5 and intellectual property search criteria as recited in dependent claims 8 and  
6 9?

7 Did the Appellants show the Examiner erred in taking Official Notice  
8 that it was well-known to access an assignee/ticker database to determine  
9 linkages between the financial database and the intellectual property  
10 database on a company basis as recited in dependent claim 10?

11 Did the Appellants show the Examiner erred in combining Rivette and  
12 Black to render obvious updated information including at least one item  
13 of financial data selected from the group consisting of Stock Price,  
14 Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio,  
15 Earnings per Share Growth-1 Yr, Earnings per Share Growth-1 Yr, Insider  
16 Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow  
17 Ratio as recited in dependent claims 7 and 14, because there was no  
18 motivation to combine Rivette and Black?

19 Did the Appellants show the Examiner erred in finding that Rivette  
20 discloses a display device suitable for the display of at least one user-  
21 selectable data item to assist with the construction of a search query having  
22 both financial search criteria and intellectual property search criteria, as  
23 recited in independent claim 15?

24 Did the Appellants show the Examiner erred in finding that Rivette  
25 anticipates the subject matter of independent claims 16 and 17?

26

1 SUMMARY OF THE DECISION

2 We affirm the rejections of claims 3, 6, 7, 10-12 and 14-16.

3 We reverse the rejections of claims 1, 2, 4, 5, 8, 9 and 13.

4 We also use our authority under 37 C.F.R. § 41.50(b) to enter a new  
5 ground of rejection: claim 10 is rejected under 35 U.S.C. § 102(e) as being  
6 anticipated by Rivette.

7

8 FINDINGS OF FACT

9 *Specification*

10 Appellants claim methods, systems and apparatuses for real-time,  
11 on-line computer searching and matching of database entries based on  
12 intellectual property and other user-selectable search criteria (p. 1, ll. 5-8).

13

14 *Rivette*

15 Rivette discloses that it would be very beneficial to have automated  
16 tools that automatically process patent related information and non-patent  
17 related information for making corporate business decisions. Existing  
18 patent-related tools do not have this capability (col. 3, lines 52-56).

19 For this and other purposes, the Rivette system includes functions for  
20 automatically analyzing the patent information 204 in conjunction with the  
21 financial information 216 (col. 11, lines 4-7).

22 The computer 1102 includes a display unit 1122, such as a computer  
23 monitor (col. 15, ll. 5-8).

24 Databases 316 store document information (that includes patent  
25 information) and information pertinent to the analysis of the document  
26 information (col. 16, ll. 19-22).

1 Many of the databases 316, such as the BOM databases 626, the  
2 inventor databases 628, and corporate entity databases 630, the financial  
3 databases 638, the person databases 632, and the employee databases 634,  
4 are initially loaded using information provided by the customer (col. 16, ll.  
5 42-46).

6 For example, the patent database 614 includes electronic  
7 representations of U.S. and foreign patents of interest to the customer.  
8 These patents may be patents owned and/or licensed by the customer,  
9 patents owned and/or licensed by competitors of the customer, patents that  
10 the customer is considering acquiring, patent that, for whatever reason, the  
11 customer is studying, etc. (col. 17, ll. 11-17).

12 The patent bibliographic databases 604 store bibliographic data about  
13 U.S. and non-U.S. patents. Such patent bibliographic data includes, but is  
14 not limited to, the information on the front page of patents, such as the  
15 assignee (col. 17, ll. 56-66).

16 In one embodiment, the patent bibliographic databases 604 store  
17 bibliographic information on all U.S. patents (col. 18, ll. 8-10).

18 The financial databases 638 store financial information pertaining to  
19 the customer's business. The financial databases 638 may also include  
20 financial information on competitors' businesses (to the extent such  
21 information is publicly known, or can be determined or estimated based  
22 on publicly known information or business practices). Such financial  
23 information may include money spent on R&D on a product line bases,  
24 gross and net revenue on a product line basis, patent licensing revenue,  
25 patent acquisition costs, etc. (col. 21, ll. 58-67).

1       The Rivette system correlates and analyzes the information in the  
2 financial databases 638 with patent information to determine, among other  
3 things, the financial impact of patents on the customer's and competitors'  
4 respective businesses (col. 22, ll. 1-5).

5       The searching module 410 in the enterprise server 314 interacts with a  
6 search engine 424 to conduct searches through the data in the databases 316  
7 pursuant to search requests from the client 304, 306. The search engine 424  
8 is any commercial and well-known search engine (col. 25, ll. 39-43).

9       The Rivette system also supports an automated search function related  
10 to groups. According to this aspect of the invention, a search is performed  
11 of all or part of the document databases 612 and/or the document  
12 bibliographic databases 602 to identify documents that satisfy a specified  
13 search criteria. The documents identified via this search are added to a  
14 specific group (col. 30, ll. 42-48).

15       The Rivette system supports performing such automatic searches at  
16 user defined intervals (such as every month), or at the occurrence of user-  
17 specified events, such as whenever the patent bibliographic databases 604  
18 are updated (col. 30, ll. 56-59).

19       The Rivette system allows the customer to define such automatic  
20 searches. In defining an automatic search, the customer specifies the target  
21 databases (what databases to search), the target groups (which groups  
22 received the identified documents), the search criteria, and the frequency or  
23 circumstances that the automatic searches take place (col. 30, ll. 60-64).



1 *Black*

Black discloses technical and fundamental financial data for analyzing securities, such as stock price, earnings per share and price-to-earnings ratios (col. 1, ll. 46-65; col. 2, ll. 8-41).

## 5

## 6 PRINCIPLES OF LAW

## 7 Claim Construction

8        While the specification can be examined for proper context of a claim  
9        term, limitations from the specification will not be imported into the claims.

10 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir.  
11 2005).

12 A claim containing a recitation with respect to the manner in which a  
13 claimed apparatus is intended to be employed does not differentiate the  
14 claimed apparatus from a prior art apparatus” if the prior art apparatus  
15 teaches all the structural limitations of the claim. *Ex parte Masham*,  
16 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Inter. 1987).

## 17

## 18 ANALYSIS

19 *Plurality of Companies*

We are not persuaded of error on the part of the Examiner by Appellants' argument that patent bibliographic database 604, patent database 614 and financial database 638 of Rivette do not include financial and intellectual property data for a plurality of companies as recited in independent claims 1, 3, 11, 16 and 17, because Rivette only discloses databases that store financial and intellectual property data for one company (Appeal Br. 12-13, 19; Reply Br. 14-15). Patent bibliographic database 604

1 stores bibliographic information on *all* U.S. patents (col. 18, ll. 8-10), patent  
2 database 614 stores patents owned and/or licensed by *competitors* of the  
3 customer (col. 17, ll. 11-17), and financial database 638 stores financial  
4 information on *competitors*’ businesses (col. 21, ll. 58-67).

5 The Appellants’ additionally assert that even if certain databases  
6 include information about competitor companies, Rivette does not  
7 contemplate searching the financial and intellectual property databases  
8 having data for a plurality of companies (Appeal Br. 12-13). However,  
9 Rivette discloses that search engine 424 conducts searches through data in  
10 databases 316, which include patent bibliographic database 604, patent  
11 database 614 and financial database 638. The data for competitors stored in  
12 patent database 614 and financial database 638 would be searched under  
13 those circumstances.

14  
15 *Relaxing Search Criteria*

16 We are persuaded of error on the part of the Examiner by Appellants’  
17 argument that Rivette does not disclose analyzing the number of common  
18 results on a company basis to determine if the number is greater than zero,  
19 and if not, relaxing the search criteria employed in at least one of the  
20 searching steps and rerunning the searches so as to obtain a non-zero number  
21 of common results as recited in independent claim 1 and dependent claim 4  
22 (Appeal Br. 13-14, 19-20; Reply Br. 10, 15).

23 The Examiner asserts that Rivette’s disclosure of a search module that  
24 is “iterative,” uses “search strategies,” and uses “manipulation” of terms  
25 corresponds to the aforementioned aspects of independent claim 1 and  
26 dependent claim 4 (Examiner’s Ans. 25-26, 34). However, these are all

1 general search terms that do not have the specificity of relaxing the search  
2 criteria as recited in independent claim 1 and dependent claim 4.

3 We also do not sustain the rejection of claim 5 based on its  
4 dependence on dependent claim 4.

5 We further do not sustain the rejection of claim 13, as it also recites  
6 “relaxing search criteria.”

7

8 *Periodic Updates*

9 We are not persuaded of error on the part of the Examiner by  
10 Appellants’ argument that Rivette does not disclose maintaining the  
11 financial database data records and the intellectual property database  
12 records, including periodically launching an automated search of network  
13 resources to locate and update financial and intellectual property information  
14 as recited in dependent claim 6 (Appeal Br. 14; Reply Br. 11). Rivette  
15 discloses that the customer may define automatic searches of specific  
16 databases, which may include network databases 316 such as patent  
17 bibliographic database 604, patent database 614 and financial database 638  
18 (col. 30, ll. 60-64). Rivette also discloses that the automatic searches may be  
19 performed at user defined intervals, such as every month (col. 30, ll. 56-59).

20

21 *Constructing Search Query*

22 We are persuaded of error on the part of the Examiner by Appellants’  
23 argument that Rivette does not disclose constructing a search query having  
24 both financial search criteria and intellectual property search criteria as  
25 recited in dependent claims 8 and 9 (Appeal Br. 14; Reply Br. 11). Rivette  
26 generally discloses search modules for searching various databases 316,

1 including financial database 638, patent bibliographic database 604 and  
2 patent database 614. However, Rivette does not disclose a specific query  
3 including *both* financial search criteria *and* intellectual property search  
4 criteria as recited in dependent claims 8 and 9.

5  
6 *Linkages Between Databases*

7 Appellants assert that the Examiner erred in taking Official Notice  
8 that it was well-known to access an assignee/ticker database to determine  
9 linkages between the financial database and the intellectual property  
10 database on a company basis as recited in dependent claim 10 (Appeal Br.  
11 17-19; Reply Br. 12-14). We make no representations as to the sufficiency  
12 of either the Official Notice or the traversal of the Official Notice. However,  
13 Rivette discloses that patent bibliographic database 604 includes assignee  
14 information (col. 17, ll. 56-66). Rivette also discloses that financial database  
15 638 includes financial information on competitors' businesses (col. 21, ll.  
16 58-67). Rivette further discloses that the financial and patent information is  
17 correlated and analyzed to make corporate business decisions on particular  
18 companies, which would have to be one of the parent company, a customer  
19 or a competitor (col. 22, ll. 1-5; col. 3, ll. 52-56). Thus, the correlating of  
20 financial and patent information in Rivette corresponds to the determining of  
21 linkages on a company basis as recited in dependent claim 10.

22 Because the rationale for the basis of this rejection differs from that  
23 set forth by the Examiner, we denominate our affirmance of the rejection of  
24 this claim as a new ground of rejection under 37 C.F.R. § 41.50(b).

*Updated Information*

We are not persuaded of error on the part of the Examiner by Appellants' argument that there was no motivation to combine Rivette and Black to render obvious updated information including at least one item of financial data selected from the group consisting of Stock Price, Price/Earnings Ratio, Current Ratio, Debt/Equity Ratio, Cash/Price ratio, Earnings per Share Growth-1 Yr, Earnings per Share Growth-1 Yr, Insider Trades, Institutional Holdings %, Price/Book Ratio, and Price/Cash Flow Ratio as recited in dependent claims 7 and 14 (Appeal Br. 20-21; Reply Br. 15). Specifically, Appellants argue that there is no motivation to combine Rivette and Black because Rivette is directed to patent and group centric data processing, while Black is directed to analysis of securities. However, Rivette discloses analyzing patent information in conjunction with financial information (col. 11, ll. 4-7) and that it would be very beneficial to have automated tools that automatically process patent related information and non-patent related information for making corporate business decisions (col. 3, ll. 52-56). Black discloses some of the financial information set forth in dependent claims 7 and 14, for example, stock price, earnings per share and price-to-earnings ratios (col. 1, ll. 46-65; col. 2, ll. 8-41). Accordingly, one of ordinary skill in the art would be motivated to combine Rivette and Black such that the financial information of Black could be used in conjunction with the patent information of Rivette to make corporate business decisions as desired in Rivette.

1           *Display Device*

2           We are not persuaded of error on the part of the Examiner by  
3 Appellants' argument that Rivette does not disclose a display device  
4 suitable for the display of at least one user-selectable data item to assist with  
5 the construction of a search query having both financial search criteria and  
6 intellectual property search criteria, as recited in dependent claim 15 (Reply  
7 Br. 11-12). The Appellants argue that the recited display device is  
8 *actually displaying* at least one user-selectable data item to assist with  
9 the construction of a search query having both financial search criteria and  
10 intellectual property search criteria. However, no such limitation is set forth  
11 in the claims. *See CollegeNet, Inc.*, 418 F.3d at 1231.

12           All dependent claim 15 recites is that the display device is *suitable* for  
13 displaying the recited information. By using the word "suitable," all the  
14 reference requires is a corresponding structure *capable* of performing the  
15 recited action, regardless of whether the corresponding structure is disclosed  
16 as actually performing the recited action. *See Ex parte Masham*, 2 USPQ2d  
17 at 1648. As display unit 1122, such as a computer monitor, in Rivette is  
18 *capable* of displaying all types of information, including the information set  
19 forth in the claim, the claim recitation for a display device is met.

20

21           *Independent Claims 16 and 17*

22           We are not persuaded of error on the part of the Examiner by  
23 Appellants' argument that Rivette anticipates the subject matter of  
24 independent claims 16 and 17 (Reply Br. 12). The Examiner has set forth a  
25 detailed recitation-by-recitation analysis of how Rivette discloses the subject  
26 matter of independent claims 16 and 17 (Examiner's Ans. 8-10). The

1 Appellants have failed to identify specific misapplications of the cited  
2 portions of Rivette to the recitations of independent claims 16 and 17.  
3 Accordingly, in the absence of a more detailed analysis of how the Examiner  
4 erred in applying specific citations of Rivette to specific recitations of  
5 independent claims 16 and 17, we sustain this rejection.

6  
7 CONCLUSION

8 The Appellants have failed to show that the Examiner erred in  
9 rejecting claims 3, 6, 7, 10-12 and 14-16.

10 The Appellants have shown that the Examiner erred in rejecting  
11 claims 1, 2, 4, 5, 8, 9 and 13.

12  
13 DECISION

14 The decision of the Examiner to reject claims 3, 6, 7, 10-12 and 14-16  
15 is affirmed.

16 The decision of the Examiner to reject claims 1, 2, 4, 5, 8, 9 and 13 is  
17 reversed.

18 We also use our authority under 37 C.F.R. § 41.50(b) to enter a new  
19 grounds of rejection: claim 10 is rejected under 35 U.S.C. § 102(e) as being  
20 anticipated by Rivette.

21 37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection  
22 pursuant to this paragraph shall not be considered final for judicial review.”

23 Regarding the new ground of rejection, Appellants must, WITHIN  
24 TWO MONTHS FROM THE DATE OF THE DECISION, exercise one of  
25 the following options with respect to the new ground of rejection, in order to  
26 avoid termination of the appeal as to the rejected claims:

1           (1) *Reopen prosecution.* Submit an appropriate amendment of the  
2           claims so rejected or new evidence relating to the claims so rejected,  
3           or both, and have the matter reconsidered by the examiner, in which  
4           event the proceeding will be remanded to the examiner. . . [; or]

5           (2) *Request rehearing.* Request that the proceeding be reheard under  
6           § 41.52 by the Board upon the same record. . . .

7           No time period for taking any subsequent action in connection  
8           with this appeal may be extended under 37 C.F.R. § 1.136(a).

9                         AFFIRMED-IN-PART, 37 C.F.R. § 41.50(b)

10

11    JRG

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